

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

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UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 31 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH H. MATTHEWS, III,
DAVID WM. PLUMMER,
and DAVID A. BARNES

Appeal No. 2003-0789
Application 09/422,654¹

HEARD: October 21, 2003

Before BARRETT, FLEMING, and BLANKENSHIP, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 40-48.

We affirm.

¹ Application for patent filed October 22, 1999, entitled "User Friendly Remote System Interface With Menu Highlighting," which is a division of Application 08/917,857, filed August 27, 1997, now U.S. Patent 6,313,851, issued November 6, 2001.

BACKGROUND

The invention relates to providing enhanced highlighted menu choices to enable a user to determine easily from a distance the current position of a selection on a menu. This overcomes the problem of menu choices not being adequately distinguishable from the background when computer functions are implemented on a large screen such as a large-screen television display (specification, p. 4, line 13 to p. 5, line 1). As shown in Fig. 17, and described in the specification at page 30, line 9 to page 32, line 6, the menu options 1701-1704 have rectangular shapes which are spaced by x-border and y-border parameters (set to zero in Fig. 17 so there is no space between them). A "focus frame" highlights the current selection option. The focus frame may surround a selected item, or may change the color and/or size of the selected item.

Claim 40 is reproduced below.

40. A system for highlighting a current selection comprising:

a storage for storing a list of menu options;

a display for displaying the list of menu options in response to a start or menu button, each option residing in a shape, one of said list being the current selection, each shape being separated from an adjacent shape by a spacing distance based on border parameters;

a processor for determining which of said list of menu options is the current selection, for enlarging the size of said shape, and for controlling said display to display said enlarged shape surrounding said current selection.

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The examiner relies on the following reference:

Wiggins et al. (Wiggins) 5,463,727 October 31, 1995

Claims 40-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiggins.

The rejection of claims 40-48 under 35 U.S.C. § 112, first paragraph, based on lack of written description has been withdrawn (examiner's answer, p. 2).

We refer to the Office action (Paper No. 7) and the examiner's answer (Paper No. 21) (pages referred to as "EA__") for a statement of the examiner's rejection,² and to the appeal brief (Paper No. 20) (pages referred to as "Br__") and reply brief (Paper No. 23) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Wiggins and the rejection

Wiggins, Fig. 1, discloses a menu screen 10 displaying a list of menu options 11-16. Each menu option resides in a

² The examiner's answer refers to the statement of the rejection in Paper No. 14, which refers to the statement of the rejection in the previous Office action, which is Paper No. 12, which refers to the statement of the rejection in the previous Office action, which is Paper No. 7 (an intervening Paper No. 10 being a notice of defective amendment). This does not comply with the Manual of Patent Examining Procedure § 1208 (7th ed. Rev. 1, Feb. 2000) ("Only the statements of grounds of rejection appearing in a single prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.") and should not be done by the examiner in the future.

rectangular icon (rectangular shape). One of the options, option 16, is the current selection. Each rectangular shape is separated from an adjacent shape by a spacing distance. The distance between icons (shapes) in the vertical direction is constant and the distance between icons (shapes) in the horizontal direction is constant, and it stated that "the icons that are provided in the menu may have any other desired shape, size, arrangement or other visible characteristic" (col. 3, lines 41-43). Wiggins does not mention the term "border parameter." A processor determines which of the menu options is the current selection, for example, by detecting movement of a cursor to a selected icon (col. 3, lines 24-27). The appearance of the selected icon is changed to make it stand out (col. 3, lines 27-33). One indication of selection is to outline or draw a band around the icon (col. 3, lines 27-29 & 33), i.e., enlarging the size of the shape as shown by outline 17. The examiner finds that Wiggins does not teach the menu items being displayed in response to a Start or Menu button, but takes Official Notice that displaying a menu in response to a Start or Menu button was well known and concludes that it would have been obvious to employ in Wiggins (Paper No. 7, p. 3). This conclusion is not challenged.

Analysis

Appellants argue (Br6): "Wiggins does not teach or suggest each shape being separated from an adjacent shape by a spacing distance based on border parameters. Wiggins does not teach or suggest border parameters at all." It is argued that "Figure 1 in the Wiggins' disclosure illustrates menu items separated by a distance, however, there is no teaching or suggestion of each shape being separated from an adjacent shape by a spacing distance based on border parameters" (Br7).

It is true that Wiggins does not describe spacing the rectangular icons using on the terminology "border parameters." Nevertheless, we conclude that the limitation "each shape being separated from an adjacent shape by a spacing distance based on border parameters" is suggested by Wiggins. Appellants' specification describes the "border parameters" as follows (p. 31, lines 15-16): "Two related parameters 'x-border' and 'y-border' represent the spacing between elements in the x and y directions, respectively." Thus, the border parameters are the spacing between elements in the x and y directions, the spacing between borders of the elements. Wiggins states that "the icons that are provided in the menu may have any other desired shape, size, arrangement or other visible characteristic" (col. 3, lines 41-43). The fact that there may be any arrangement of icons suggests to one of ordinary skill in the art of interface

design that the arrangement, such as the spacing between rectangular icons in Fig. 1 of Wiggins, can be set as a matter of design preference. In any case, however, Fig. 1 of Wiggins shows one arrangement of rectangular icons having a constant spacing between two rectangular icons in the vertical ("y") direction and a constant spacing between the two rectangular icons in the horizontal ("x") direction. The amount of spacing specified between elements shown Wiggins can be described in many different words, including "border parameters"; the actual terminology used to describe the predetermined visible amount of space around an icon is not important. That is, the designer of the rectangular arrangement of icons in Fig. 1 must have specified a particular distance between icons in the vertical direction (as evidenced by the fact that the spaces between icons 11 and 12, 12 and 13, 14 and 15, and 15 and 16, are the same) and in the horizontal direction (as evidenced by the fact that the spaces between icons 11 and 14, 12 and 15, and 13 and 16, are the same); these specified distance values can be called anything, including "border parameters." The spacing distance between icons is set to this predetermined value and, so, the distance can be termed a "spacing distance based on border parameters."

In the examiner's answer, the examiner states (EA4):

Wiggins discloses in figure 1, rectangle 11 separated from rectangle 12 by a horizontal [sic, vertical] spacing distance between the two rectangles. Similarly, rectangle 11 [is] separated from rectangle 14 by a vertical [sic,

horizontal] spacing distance between the two rectangles. The border parameters of the rectangles, which are the length and width of each rectangle defined by screen pixel coordinates defines the spacing distance. Thus as can be clearly seen in figure 1, the spacing distance between rectangles 11 and 12 is based on the borders of rectangles 11 and 12. Similarly, the spacing distance between rectangles 11 and 14 is based on the borders of rectangles 11 and 14. [Emphasis added.]

Appellants dispute the statement underlined above and argue that even if the "border parameters" encompass the length and width of each rectangle, Wiggins would still not teach or suggest a spacing distance based on border parameters (RBr2-3).

It appears that the examiner is trying to interpret the claim in such a way that "border parameters" are the positions of the horizontal and vertical borders of the rectangular icons in Wiggins, instead of the spacing between elements as described in the specification at page 31, lines 15-16. Although we agree that border parameters, as broadly claimed, could be interpreted to refer to the borders of the rectangles, this does not address the actual claim language of "each shape being separated from an adjacent shape by a spacing distance based on border parameters." While the border parameters, as defined by the examiner, of two adjacent rectangles determine a spacing distance, it does not seem accurate to say that the distance is "based" on border parameters. Nevertheless, as discussed in the second paragraph of this section, we conclude that the limitation of "each shape being separated from an adjacent shape by a spacing distance

based on border parameters" would have been suggested to one of ordinary skill in the art by Fig. 1 of Wiggins.

Appellants argue (RBr4):

Wiggins does not teach or suggest the spacing distance based on border parameters. At best, the distance between rectangles in Fig. 1 of Wiggins is randomly determined as there is no discussion at all in Wiggins as to how it is determined, if at all. This is very different from the present invention where each shape is separated from an adjacent shape by a spacing distance based on border parameters.

As discussed, although Wiggins does not mention the terminology "border parameters," the rectangular icons in Fig. 1 of Wiggins are spaced from adjacent icons in the x and y directions by specified distances, which can be termed "border parameters." The distances are clearly specified or they would not appear constant in Fig. 1. Thus, the icons are separated by a "spacing distance based on border parameters." The fact that the arrangement of icons is not important to Wiggins and, so, is not described in words, does not negate the teaching value of the uniform spacings shown in Fig. 1. Nor does the lack of textual discussion imply that the distance is "randomly determined," as argued, since Fig. 1 clearly shows uniform, not random, spacings.

At the oral hearing, counsel argued that Wiggins does not disclose controlling the spacing based on "border parameters."

We do not find the argument about "controlling" in the briefs. The Board's decision is based on the written record, not on new arguments presented for the first time at oral hearing,

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see Manual of Patent Examining Procedure § 1206 (8th ed. Aug. 2001) (citing In re Chiddix, 209 USPQ 78 (Comm'r Pat. 1980)). We will not speculate on how the claims could be amended to define patentable subject matter. If the claims recited "controlling a spacing distance based border parameters," the examiner could take the position that the icons in Wiggins are controlled by the computer to take a distance between icons based on a distance (a "border parameter") specified by the menu designer. The examiner could also apply an additional reference to show that the size, shape, and spacing of graphical items on a display are controlled by setting of parameters, which appears to be something that assignee Microsoft could admit to be known.


For the reasons discussed above, we conclude that the examiner established a prima facie case of obviousness which appellants have not shown to be in error. The rejection of claims 40-48 is sustained.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


LEE E. BARRETT
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

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HOWARD B. BLANKENSHIP
Administrative Patent Judge

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